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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,823	05/15/2007	Armin Schneider	4266-0126PUS1	2434

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EXAMINER

PITRAK, JENNIFER S

ART UNIT	PAPER NUMBER
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1635

NOTIFICATION DATE	DELIVERY MODE
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08/06/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/589,823	Applicant(s) SCHNEIDER ET AL.	
	Examiner JENNIFER PITRAK	Art Unit 1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 21 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 21 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/01/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Remarks

Applicant's amendments and arguments filed 05/01/2009 have been entered and considered. Claims 1-16, 18-20, 22-29, and 31 are canceled. Claims 17, 21, and 30 are under examination. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification - objections withdrawn

The amendments to the specification have obviated the objections. Therefore, the objections are withdrawn.

Claim Objections - Withdrawn

The amendments to the claims have obviated the objection to claim 30. Therefore the objection is withdrawn.

Claim Rejections - 35 USC § 112 and 101 - Withdrawn

The amendments to the claims have obviated the rejection under 35 U.S.C. 112, second paragraph, and 35 U.S.C. § 101. Therefore, the rejection is withdrawn.

Claim Rejections - 35 USC § 112 - Withdrawn

The amendments to the claims have obviated the rejection under 35 U.S.C. 112, first paragraph. Therefore, the rejection is withdrawn.

Claim Rejections - 35 USC § 102 - Maintained

Claims 17, 21, and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wiley (2002, U.S. PGPub 2002/0041876, of record). This rejection is maintained for the reasons of record.

Response to arguments

Applicant argues that because Wiley lists compounds for modulating TWEAKR or TWEAK to treat a plethora of disease states, Wiley does not anticipate the instant claims. Case law has been cited in support of Applicant's position; however, no explanation of how the facts in the cited cases relate to the instant case has been presented. Applicant's arguments are not persuasive because, as cited in the rejection, Wiley teaches methods of treating and preventing ischemia of the brain (stroke) by administering an antisense nucleic acid target to TWEAK and that such nucleic acids are typically administered with pharmaceutically acceptable carriers and can be delivered with retroviral and adenoviral vectors. Therefore, Wiley anticipates the instant claims.

Claim Rejections - 35 USC § 103 - Maintained

Claims 17, 21, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiley, and further in view of Bass (2001, Nature, v.411:428-9) and Elbashir, et al. (2001, Nature, v.411:494-8). This rejection is maintained for the reasons of record.

Response to arguments

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Applicant argues that Bass fails to rectify the deficiencies of Wiley, but Applicant does not indicate how or why Bass fails to rectify the deficiencies of Wiley. Applicant also argues that the cited references do not provide a reasonable expectation of success. This is not persuasive because Wiley clearly anticipates the instant claims and Bass is relied upon to teach that siRNAs are more robust than antisense nucleic acids for target inhibition and, therefore, one of skill in the art would have a reasonable expectation of success in using siRNAs in place of the antisense nucleic acids taught by Wiley.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER PITRAK whose telephone number is (571)270-3061. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James (Doug) Schultz can be reached on 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jennifer Pitrak
Examiner
Art Unit 1635

/Sean R McGarry/

Primary Examiner, Art Unit 1635